

Amendment and Response
U.S. Patent Application No. 10/040,911
Page 7 of 11

REMARKS

Claims 1-12 are pending. Claims 13-40 have been cancelled without prejudice in response to a Restriction Requirement mailed by the U.S. Patent and Trademark Office on July 10, 2006.

Claims 2, 4-9, 10, and 12 have been amended. Claims 41-45 are new. Support for the new claims can be found in the specification, for example, at Paragraphs [0006], [0007], [0011], [0016], [0018], and [0066]. Applicant respectfully requests entry of these amendments and new claims.

Claim Rejections

Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. 2002/0042763 (“Pillay”).

Without conceding the correctness of the rejections, Applicants respectfully traverse.

To be a proper rejection under 35 U.S.C. § 102, a reference must teach every element of the claim, as arranged in the claim.

Applicants respectfully submit that Pillay, taken as a whole, fails to teach or suggest every element of Applicants’ independent claims 1 and 9. Pillay fails to teach or suggest at least providing assurance to a user of “*the identity of a trading counterpart*” by “paying by said insurer...benefits...resulting from the misidentified or misrepresented identity,” in an online marketplace transaction via an insurance policy as recited by Applicants’ original claim 1 and claim 9 as amended.

Pillay, which is owned by the assignee of record of the instant patent application, is directed to providing trade credit information and/or trade credit insurance information. As

EXPRESS MAIL MAILING LABEL NO. EV931176568US

Amendment and Response
U.S. Patent Application No. 10/040,911
Page 8 of 11

stated in Pillay, the purpose of trade credit information and/or trade credit insurance information is “to protect against accounts receivable losses, to eliminate the need for self-insurance of accounts receivable, and to eliminate the need to seek protection against receivables losses from specialist broker networks.” See ¶ [0026]. In general, the trade credit contemplated by Pillay is offered between business counterparts whose identities are known to each other but whose creditworthiness is not known. See ¶ [0025]. Pillay does not teach or suggest a system or methods in which the identity of one of the trading counterparts (e.g., the provider, seller, or lessor of goods) or the other trading counterpart (e.g., the customer or client) is in question. In particular, Pillay discusses the factors associated with determining whether to offer trade credit in the first instance or whether to provide insurance to reduce accounts receivables losses. See ¶¶ [0026], [0058].

In contrast, Applicants claims are generally directed to anonymous on-line transactions in which the identity of one or more of the trading counterparts is in question. Specifically, Applicants claims 1 and 9 recite providing assurance of the “identity” of a trading counterpart to cover losses by paying benefits on an insurance policy where the benefits result from misidentification or misrepresentation of a trading counterpart’s identity in an online marketplace transaction. See ¶ [0033]. Pillay nowhere teaches or suggests providing insurance to cover losses from misidentification or misrepresentations as to identity of a trading counterpart or paying benefits resulting from the misidentification or misrepresentation of identity.

The Office Action “interprets inability to pay as a misrepresentation of a customer/trading counterpart.” However, Applicants respectfully submit that support is not

EXPRESS MAIL MAILING LABEL NO. EV931176568US

Amendment and Response
U.S. Patent Application No. 10/040,911
Page 9 of 11

provided for that interpretation based on Applicants' specification. Instead, Applicants' independent claims are directed to providing assurance for the "identity of a trading counterpart" and "paying...benefits...[to an insured]...resulting from...the misrepresented or misidentified identity."

Additionally, the processes and/or algorithms considered in determining whether to issue, at what premium, and policy limits of an insurance policy to cover losses from misidentification or misrepresentation of identity of a trading counterpart are different from the factors used to make similar determinations regarding trade credit insurance. For example, whether a trading counterpart is a verified user (e.g., a user that has a unique identifier or security credential) can be used to determine whether to issue an insurance policy, at what premium, and at what policy limits. Therefore, Pillay fails to teach or suggest at least assurance of the identity of a trading counterpart or paying benefits resulting from misidentification or misrepresentation of identity of a trading counterpart in an online marketplace transaction.

For at least these reasons, Pillay fails to teach or suggest every element of Applicants' claims 1 and 9, and therefore, claims 1 and 9 should be allowable. Claims 2-8, and 10-12 depend directly or indirectly on claims 1 and 9, and Applicants respectfully submit that these claims also recite patentable subject matter for at least the same reasons.

New Claims

Claims 41-45 are new and recite additional features of Applicants' invention including, for example, features used to determining or calculating an insurance premium for providing assurance of the identity of a trading counterpart. Support for the new claims can be found in the specification at, for example, Paragraphs [0006], [0007], [0011], [0016], [0018], [0066], and in

EXPRESS MAIL MAILING LABEL NO. EV931176568US

Amendment and Response
U.S. Patent Application No. 10/040,911
Page 10 of 11

now-canceled claims 29-34. Claims 41-45 depend directly or indirectly from claim 1, and Applicants respectfully submit that claims 41-45 recite patentable subject matter for at least the same reasons as claim 1.

Amendment and Response
U.S. Patent Application No. 10/040,911
Page 11 of 11

CONCLUSION

In view of the foregoing remarks, and the inability of the applied references, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and a notice to that effect is respectfully requested.

The Examiner is cordially invited to contact the undersigned Attorney to discuss any issues that remain so that the present application can be put in condition for allowance.

Respectfully submitted,



Joseph A. Capraro, Jr.
PROSKAUER ROSE LLP
Attorney for Applicants
One International Place
Boston, MA 02110
Telephone: (617) 526-9600

Date: March 6, 2007
Reg. No. 36,471